

Neifeld Docket No: PIP-69A-KATZ
BPAI appeal docket no: 2008-5179.

Application/Patent No: 09/776,714

USPTO CONFIRMATION NO: 2896

File/Issue Date: 2/6/2001

Inventor/Title: Gary M. KATZ/Method and System for Timing Promotions Based on a Prior Receipt of Promotions

Examiner/ArtUnit: ALVAREZ/3688

Entity status: LARGE

**37 CFR 1.7(c) FILING RECEIPT AND TRANSMITTAL LETTER WITH
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

1. **THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY FEES
WHICH MAY BE REQUIRED, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT
ACCOUNT NUMBER 50-2106.**

2. **FEES PAID HERewith BY EFS CREDIT CARD SUBMISSION: \$ 0**

A. CLAIMS FEES

\$ - (claims previously paid for; currently present; \$52 per addl. claim over 20.)

\$ - (independent previously paid for; currently present; \$220 per addl. claim over 3)

B. OTHER FEES

FEE FOR NOTICE OF APPEAL AND FEE FOR APPEAL BRIEF, TOTALING \$:

3. **THE FOLLOWING DOCUMENTS ARE SUBMITTED HERewith:**

37 CFR 41.41 REPLY BRIEF

4. **FOR INTERNAL NEIFELD IP LAW, PC USE ONLY**

USPTO CHARGES \$: 0 CLIENT BILLING MATTER: PIP-69A-KATZ BANK ACCOUNT/Check: 6/ G/L ACCOUNT: 5010	FIRM CHARGES\$: 0 DESCRIPTION: FIRM CHARGE FOR . LAWYER:
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INITIALS OF PERSON WHO **ENTERED** ACCOUNTING DATA: RAN

ATTORNEY SIGNATURE (AUTHORIZING DEPOSIT ACCOUNT) /RichardNeifeld#35,299/

Printed: October 15, 2010 (7:41pm)

Richard Neifeld

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ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22213-1450

37 CFR 41.41 REPLY BRIEF

Sir:

In response to the Answer dated 10/12/2010, the applicant replies as follows.

The Answer through the middle of page 6 merely restates the preexisting rejections. Answer page 6 line 13 to page 7 line 2 asserts that:

(10) Response to Argument

Appellant argues Barnett doesn't teach determining, using said processor, and based at least in part upon said first consumer demographic characteristic, a time at which to transmit to said first consumer a subsequent promotion offer. The Examiner disagrees with Appellant because ***Barnett teaches using consumer demographic data 42 and "when the printed coupons are presented at a retail store" (redemption information) (Abstract) to determine subsequent coupon packages (see Figure 10).*** Therefore contrary to Appellant's arguments, Barnett teaches analyzing redemption information including when (time) the printed coupons are presented in order to determine subsequent coupon packages to the customers. The coupon packages reflect the user's demographic data and redemption information including when (time) the coupons are being redeemed in order to determine what type and when (time) to present subsequent promotion offers to the users. [Bold and italics added for emphasis.]

In response, the undersigned initially submits that the examiner maintaining the rejections is a travesty and requests that the panel make appropriate comments in their opinion in order to dissuade this type of examiner behavior in the future.

Claim 65's limitation "determining, using said processor, and based at least in part upon

said first consumer demographic characteristic, a time at which to transmit to said first consumer a subsequent promotion offer" does not take knowledge of rocket science to understand. It requires a "determining ... a time at which to transmit ... a subsequent promotion offer." In the Answer, the examiner interpreted this recitation to mean, instead, "determining ... a subsequent promotion offer ... when ..." coupons are presented for redemption. Such a claim interpretation is clearly wrong, and clearly contrary to the examiner 2009 understanding of claim 65 as noted below.

The examiner's claim construction in the Answer requires claim 65's recitation "determining, using said processor, and based at least in part upon said first consumer demographic characteristic, a time at which to transmit to said first consumer a subsequent promotion offer" to mean **"when the printed coupons are presented at a retail store" ... to determine subsequent coupon packages (see Figure 10).**" This improper interpretation is *inconsistent* with the examiner's express prior claim construction of claim 65 earlier in prosecution, in late 2009.

The examiner's prior claim construction is express. It appears in her prior rejection of claim 65 over Kepecs in the office action dated 11/30/2009. (The applicant subsequently antedated Kepecs.) Therein, the examiner rejected claim 65, including parenthetically her interpretation of claim 65's recitation "determining, using said processor, and based at least in part upon said first consumer demographic characteristic, a time at which to transmit to said first consumer a subsequent promotion offer" recitation. In that office action, she stated the following:

a processor determining a time at which promotions is to be provided based upon

said identified one or more parameters related to promotions received by said consumer (*i.e. determining the time period to offer the second offer to the consumer based on previous offers redeemed by the customer*)(col. 3, lines 49 to col. 4, lines 1-8).

Thus, when rejecting claim 65 over Kepecs, the examiner construed claim 65's "determining ... a time at which to transmit " to mean "**determining the time period to offer the second offer to the consumer based on previous offers redeemed by the customer**". That is, of course, roughly what claim 65 defines under any reasonable claim interpretation. Claim 65 defines a time when to transmit a new promotion to the consumer, (in which the time or time period is based in some part upon consumer specific demographic data).

That roughly proper interpretation of claim 65 is *inconsistent* with the interpretation implied in the Answer. The Answer implies that claim 65 means determining new coupons to offer for the consumer at the time, that is, when, existing coupons are presented by the consumer for redemption.

The argument in the Answer is based upon a clearly improper interpretation of claim 65, one inconsistent with the examiner's prior interpretation of claim 65, and inconsistent with the clear meaning of claim 65, improperly delays allowance of this application, and therefore is a travesty as noted above.

Barnett's abstract is also unrelated to the relevant claim limitation. Specifically, independent claim 66 recites "determining, using said processor, and based at least in part upon said first consumer demographic characteristic, a time at which to transmit to said first consumer a subsequent promotion offer." Barnett's abstract contains nothing suggesting a time

determination, "determining ... a time at which to transmit to said first consumer a subsequent promotion offer." What the sentence in Barnett's abstract that is partially quoted in the Answer states is "When the printed coupons are presented at a retail store, the discount is provided to the user." All that sentence indicates is that coupons are redeemed in response to their presentation. That sentence contains no indication of a processor making a time determination, much less the claimed determination of when to send promotion offers to the consumer.

The Answer also refers to Barnett Figure 10, without any specificity. However, all Barnett Figure 10 shows relating to promotion offers is in the bottom most box which states only "Analyze data to determine subsequent promotions". The undersigned hastens to point out the claim 65 does not define determining subsequent promotions, and instead defines "determining, ..., a time at which to transmit ... a subsequent promotion offer." Accordingly, reference in the Answer to Barnett Fig. 10 is meaningless.

This issue noted above is not a "close call". It is clear error to have maintained the rejections over Barnett through appeal.

Answer page 7 line 3 to 15 asserts that:

With respect to the Official notice taken pertaining "that it is old and well known for promoters, advertisers and the like to account for how valuable or profitable a consumer is in order to time promotions accordingly. For example, a consumer that makes more purchases will receive offers more often than a consumer that doesn't redeem their offers in order to time offers accordingly"

Appellant argues that the conclusion is non sequitur because according to Appellant receiving more coupons is not the same as receiving coupons at

different times. The Examiner respectfully disagrees with Appellant because if a consumer A being a consumer that makes more purchases than consumer B will receive coupons more often and at more times than consumer B which receives coupons less often. Therefore Consumer A and B will receive coupons at different times. Consumer A receiving coupons most of the time and consumer B receiving coupons sometimes.

First, the official notice does not support the rejection. Again, the import of this official notice is that a consumer receives coupons at the time of making a purchase transaction, as noted in the Barnett abstract. And so a more frequent purchaser would more frequently receive coupons. Who cares? That is not what claim 65 defines. As noted above, independent claim 65 recites:

determining, using said processor, and based at least in part upon said first consumer demographic characteristic, a time at which to transmit to said first consumer a subsequent promotion offer.

The examiner has not identified a "processor" that makes a "determination" of "time at which to transmit to said first consumer a subsequent promotion offer".

Second, the applicant maintains that the official notice is improper and cannot be relied upon by the panel as facts in support of a panel decision. For one thing, the examiner's reasoning in the Answer is again flawed. It is flawed because it contains a conclusion based upon a conclusion, not a conclusion supported by facts or reasoning. What the examiner first states is the following conclusion: (1) "consumer A being a consumer that makes more purchases than

consumer B will receive coupons more often and at more times than consumer B which receives coupons less often. " That is a conclusion without factual support that A will get more coupons because A makes relatively more purchases. And then the examiner again concludes that conclusion supports her ultimate conclusion (2) " Therefore Consumer A and B will receive coupons at different times." The first factless conclusion (1) appears to be the implied factual basis for the second factless conclusion (2). That is a classic case of circular logic, and cannot be persuasive. What the examiner has not asserted is (1) the prior art suggests providing to a consumer that makes relatively more purchases, relatively more coupons. And the examiner has not explained why (or that the prior art teaches) it would logically follow that a processor that determines when to provide coupons to a consumer, would base its timing determination the amount of purchase of the consumers. Certainly Barnett teaches no timing related determination.

The same considerations noted above also apply to the other independent claims, claims 75, 87, and 88 .

Truly, /RichardNeifeld#35,299/

RICHARD NEIFELD, REG. NO. 35,299

ATTORNEY OF RECORD

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